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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,898	01/25/2006	Basil S Shorosh	CGI020273US01	6095
38550 7590 05/01/2008 CARGILL, INCORPORATED LAW/24 15407 MCGINTY ROAD WEST WAYZATA, MN 55391				
EXAMINER				
MEHTA, ASHWIN D				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
05/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,898

Applicant(s)

SHORROSH ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-10, 14-16, 20, 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 14-16, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01252006: 08022007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1, 3-10, 14-16, 20, and 21 in the reply filed on November 27, 2007 is acknowledged.

Specification

2. The specification is objected to because Table 4 on page 28 is "cut off" on the right side. Correction is required. New matter must be avoided.

Claim Objections

3. Claims 14-16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Parent claim 1 is drawn towards any isolated nucleic acid having at least 30% sequence identity to SEQ ID NO: 1. Dependent claims 14-16 limit the nucleic acid of claim 1 to being at least 50, 100, or 500 nucleotides in length, respectively. However, SEQ ID NO: 1 consists of 2400 nucleotides. Claims 14-16 encompass nucleic acid sequences that could not have at least 30% identity to the entirety of SEQ ID NO: 1, and the claims therefore fail to further limit parent claim 1.

4. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3-9, 14-16, 20, and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO: 1, does not reasonably provide enablement for isolated nucleic acids differing from SEQ ID NO: 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification discusses the cloning and sequencing of 5' untranslated regions from the 11S globulin (SEQ ID NO: 2, not elected) and 2S albumin (SEQ ID NO: 1, elected) genes of sesame plants (pages 2-3; Figure 1). Example 2 discusses the analysis of its sequence and identification of several regulatory elements found within SEQ ID NO: 1 (Table 1). Example 3 discusses assays showing the functionality of SEQ ID NO: 1 in transcribing an operably linked GUS sequence in transient expression assays in Brassica leaves and Example 4 discusses its functionality in transgenic Brassica plants (Tables 3 and 4).

Claim 1 is drawn towards any isolated nucleic acid having at least 30% sequence identity to SEQ ID NO: 1. Claim 3 limits claim 1 by requiring any heterologous nucleic acid to be

operably linked to the nucleic acid of claim 1. Claims 4 and 5 are drawn to transgenic plant cells or plants comprising the construct of claim 3. Claims 6 and 7 are drawn towards methods of making transgenic plant cells or plants comprising introducing the construct of claim 3 into a plant cell or plant. Claims 8, 9, 20, and 21 limit the nucleic acid of claim 1 to having at least 75%, 95%, 85%, or 98% identity, respectively, to SEQ ID NO: 1. Claims 14-16 depend from claim 1 and indicate that the nucleic acid is at least 50, 100, or 500 nucleotides in length, respectively.

The claims do not limit the functions of the encompassed nucleic acids, and therefore the claimed nucleic acids may have any function. However, while the specification teaches that SEQ ID NO: 1 has promoter activity, it does not teach any other function for the nucleic acids encompassed by the claims. It is unclear how one skilled in the art is to use the claimed nucleic acids, other than SEQ ID NO: 1, as other functions are taught by the specification. In the absence of further guidance, undue experimentation would be required by one skilled in the art to determine the functions of isolated nucleic acids that differ from SEQ ID NO: 1. As the functions of the claimed nucleic acids are not taught, one skilled in the art would also not know how to use the claimed transgenic plant cells and plants, other than those transformed with a nucleic acid construct comprising SEQ ID NO: 1. See *Genentech, Inc. v. Novo Nordisk, A/S*, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997), which teaches that “the specification, not the knowledge of one skilled in the art” must supply the enabling aspects of the invention. Given the breadth of the claims, lack of guidance of the specification and unpredictability of the art, undue experimentation would be required by one skilled in the art to make and use the claimed invention.

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Contact Information

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at 571-272-0975. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

April 30, 2008

/Ashwin Mehta/
Primary Examiner, Art Unit 1638